REMARKS

In the April 3, 2006 Office Action, the Examiner raised certain issues related to the claims 1-10. These issues are fully addressed in the remarks below. Additionally, new independent claims 11 and 12 have now been added. Applicant respectfully submits that all twelve claims are allowable.

A. Claims 1-10

Claims 1-8 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Popa et al (U.S. Patent No. 5,991,783) in view of Nagaska (U.S. Patent No. 6,505,252). Claims 9 and 10 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Popa et al (U.S. Patent No. 5,991,783) in view of Nagaska (U.S. Patent No. 6,505,252) and further in view of PrePRESS (PrePRESS Technology Reports, "Open Prepress Interface(OPI)")('Prepress'). For the foregoing reasons, these rejections are respectfully traversed.

Independent claim 1 of applicant's invention meets the non-obviousness requirements of 35 U.S.C. § 103(a) for a number of reasons. The Examiner has acknowledged that neither the Popa et al patent nor the Nagasaka patent disclose the present invention individually. Further, the combined teachings of these two patents would not have suggested to one of ordinary skill in the art the invention claimed by applicant.

The Popa et al patent relates to primarily to a file system for storing digital photographs. This system involves a main master file and a main preview file. Both files include a resource fork with a thumbnail image and a data fork that includes information related to color (cyan, magenta, yellow and black) to produce various hues. The file can

be modified using a program such as Adobe Photoshop to crop the image, rotate the image, adjust coloring, adjust resolution and add text to the image. Popa et al does not disclose applicant's separately created database containing data related to the images and linking the images to the data in the database.

Popa et al also discloses that an image can be added to a page using, for example, QuarkXPress which is capable of combining text with the image. More specifically, Popa et al discloses a layout page data file 182. However, this page layout file 182 is very different than applicant's "panel". While applicant's panel, as required by claim 1, contains low resolution versions of the image, Popa's "layout page data file 182 does not contain the actual graphical data ... Instead, the layout page data file 182 merely contains a pointer 184, for example, pointing to the location of the main preview file 120 in data storage 12". See Col. 8, line 64 – Col 9, line 8. Thus, Popa et al teaches away from applicant's invention that includes a panel that contains low-resolution versions of images that can be placed into a page.

Popa et al teaches nothing about the use of a first computer system on which images and a database are stored and using a second computer at a location remote from the first computer system. Thus, it teaches nothing about using the second computer to communicate a desired page layout and a desired manner in which images should be grouped to a first computer system that creates and stores a file panel, based upon said communication, that contains low-resolution versions of said grouped images. Finally, Popa et al teaches nothing about placing such a panel into a page, communicating to the first computer system that the page is acceptable, having the first computer modify the

acceptable page by changing the low-resolution images to high-resolution images, and printing the page.

The Nagasaka patent does not relate to a method for creating a publication. Instead, it relates to a data transfer utility. This data transfer involves storing original data and preview file data on a data server 200, transmitting the preview data to a computer system 100, sending a request for the original data from the computer system 100 to the data server 200 and then sending the original data from the data server 200 to the computer system 100 in response to the request. The original data can then be used by the computer system 100 to print on a printer 180 attached to the computer system 100. Further, the tasks performed by Nagasaka's data server 200 and Nagasaka's computer system 100 are completely different than the tasks performed by applicant's invention.

First, Nagasaka does not disclose collecting data related to the images or creating a database linking the images to the data on either server 200 or computer system 100. Second, Nagakaka's computer system 100 is never used to communicate to the server 200 a desired page layout or the manner in which images should be grouped. Thus, Nagasaka's server 200 does not create and store as a file a panel based upon the desired page layout and manner in which the images should be grouped. Nagaskska does not disclose anything comparable to a panel stored as a file containing low resolution versions of grouped images. Fourth, neither Nagasaka's server 200 nor computer system 100 are used to place such a panel into a page or communicate when the page is acceptable. Fifth, there is no swapping of images on such a page by the server 200

modifying the acceptable page by changing the low-resolution images to high-resolution images

In summary, the basic concepts of applicant's invention related to storing images and data at one location and manipulating said data and images from a second location to create pages of a publication without transferring large high resolution image files between the two locations is simply not taught by Popa et al, Nagasaka or the combination thereof. As such, claim 1 and dependent claims 2-10 are all patentable over the art of record.

B. Claims 11 and 12

New independent claims 11 and 12 are patentable over the art of record for many of the same reasons discussed above. Claim 11 includes all the limitations of claim 1 and adds the requirement that once the creation of the database is complete, at lease one of the plurality of second computers is notified. This step is also neither taught nor suggested by Nagasaka and Popa et al.

Claim 12 clarifies the nature of the data contained in the database. Specifically, claim 12 requires that the images are of subjects and at least some of the data collected and stored in the database relates to the subjects portrayed in the images. In connection with yearbook publications such data includes the names, grades, teachers, etc. related to the people portrayed in the images. As noted above, no such database is disclosed in either Nagasaka or Popa et al.

Conclusion

In evaluating patentability under 35 USC § 103 it is impermissible "simply to engage in a hindsight reconstruction of the claimed invention, using applicant's structure

as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982 (Fed. Cir. 1991). To protect against the improper use of hindsight, there must be some suggestion to combine the references. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). "The motivation to combine references can not come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., 21 F.3d 1068 (Fed. Cir. 1993). The case law makes clear that "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Ecolochem v. Southern California Edison, 227 F.3d 1361 (Fed. Cir. 2000).

As noted above, the cited references do not teach elements of the claimed combination. Further, they provided no teaching, suggestion, or motivation that would lead one to applicant's claimed invention. As such, applicant respectfully submits that the claims are in condition for allowance and requests such action.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment (10 pp) in application Serial No. 10/624,207, filed July 22 2003, is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, postage prepaid, on June 30, 2006.

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On Behalf of C.G. Mersereau